

Reply to May 25, 2006 Office Action  
Application No. 10/068,533  
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REPLACEMENT FIGURES

Please replace Figures 1-25 with Replacement Figures 1-25 attached hereto.

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## REMARKS

Applicant appreciates the time taken by the Examiner to carefully review Applicants' present application. At the time of the Office Action mailed May 25, 2006, Claims 12, 22-26, 51 and 52 were pending in this Application and stood rejected. Claims 1-11, 13-21 and 27-50 were previously withdrawn. Claims 12 and 51 have been amended. Applicants respectfully request reconsideration and favorable action in this case.

### Rejections under USC §102

Claims 12, 51 and 52 stand rejected under Section 102 as being anticipated by US Patent No. 5,403,311 granted to Abele ("Abele"). Claims 12, 23, 51 and 52 also stand rejected under Section 102 as being anticipated by US Patent No. 5,507,743 granted to Edwards ("Edwards"). Applicants respectfully traverse.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 *citing Verdegaa Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

As amended, Independent Claims 12 and 51 each recite a method of treating a target tissue including using an electrosurgical probe with a return electrode having a coil with gaps formed between the coils and aspirating the ablated tissue through a suction lumen formed in the electrosurgical probe.

### The Abele reference

The Abele reference shows a catheter having a rounded end with helical etched gold electrodes 58 and 60 formed proximate a distal needle tip electrode 56. See Figure 8. As shown, electrodes 58 and 60 wrap helically around the outer surface of the catheter and appear to be directly adjacent to one another. When used with the needle electrode 56, electrodes 58 and 60 act as a single return electrode. See Col. 9, lines 15-20. Accordingly, Abele fails to disclose, teach or suggest a return electrode coil having a gap between the coils as recited. Abele also fails to disclose, teach or suggest aspirating ablated target tissue as recited.

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The Edwards reference

The Edwards reference discloses a treatment apparatus including a straight active electrode and a helical "indifferent" electrode. See Fig. 1. As contemplated by Edwards, the active electrode is inserted into a tumor and the indifferent electrode is deployed in tissue adjacent the tumor. See Col. 5, lines 4-7. In a deployed state, the active and helical electrodes of Edwards extend approximately the same distance. Accordingly, Edwards fails to disclose an active electrode positioned distal to a coil, as recited. See Figures 4a and 4b. Also, Edwards fails to disclose, teach or suggest aspirating ablated target tissue as recited.

For at least these reasons Applicants submit that Edwards and Abele each do not anticipate Independent Claims 12 or 51, as amended. Applicants respectfully request reconsideration, withdrawal of the §102 rejections and full allowance of Claims 12, 51 and Claim 52 which depend therefrom.

Rejections under USC §103

Claims 22 and 23 stand rejected under Section 103 as being unpatentable over Abele in view of US Patent No. 5,334,193 granted to Nardella ("Nardella"). Claims 24 and 25 stand rejected under Section 103 as being unpatentable over Abele in view of US Patent No. 5,715,817 granted to Stevens-Wright ("Stevens-Wright"). Claims 26 stand rejected under Section 103 as being unpatentable over Abele in view of US Patent No. 5,348,554 granted to Imran.

Based on the remarks above, Applicants submit that Claims 22-26 depend from Claims that have been placed in condition for allowance, thereby obviating the present rejections under §103. Applicants request reconsideration, withdrawal of the rejections under §103 and full allowance of Claims 22-26.

Double Patenting Rejection

Claims 12, 22-26, 51 and 52 have been 22 and 23 stand provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over the pending claims of copending Application no. 10/072,599. Applicants submit that should the conflicting claims issue, Applicants will submit an appropriate terminal disclaimer.

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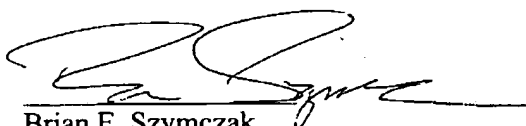
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## CONCLUSION

Applicant has made a sincere effort to address all issues raised in the Office Action. If the Examiner believes a telephone conference would expedite prosecution of this application, a telephone call to the undersigned attorney at the number listed below will be appreciated.

Respectfully submitted,



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